

REMARKS

This paper is in response to the Office Action dated August 29, 2006. Claim 1 is amended and claims 5 – 8 are added. Claims 1 – 3 and 5 – 8 are in the application upon entry of this amendment. Entry of this amendment, reconsideration and reexamination of the above-identified application are respectfully requested.

The claims are rejected under 35 U.S.C. §112, first and second paragraphs, respectively, for the reasons given on pages 2 – 3 of the official action. The specification has been amended in accordance with the Examiner's suggestion. More specifically, Applicants respectfully submit that the number "2.5" as recited in Table 1, column 1, row 4 is an obvious typographical error. The number has been replaced with "UAN" (urea ammonium nitrate). It is submitted that this is an obvious typo since UAN is referred to in the Table legend but not actually recited in the table as filed. In all compositions UAN was used at a rate equivalent to 2.5 g/ha as correctly indicated in the table. Accordingly, no new matter is presented by the amendment. Applicants aver that the rejections under § 112, first and second paragraphs, are overcome in view of the foregoing amendment to the specification.

The Examiner's presumption regarding inventorship is correct; the subject matter of the various claims in this application was commonly owned at the time any inventions covered therein were made.

The rejections of claims 1 – 3 under 35 USC 103 as being unpatentable over WO/02100173 (Cornes) or US 6,723,681 (Hacker et al.), each in view of Kent et al., are respectfully traversed as applied to claims 1 – 3 and as they might be applied to new claims 5 – 8.

Applicants note that the subject matter of the instant claims is a process for reducing injury in a crop comprising sorghum from application of a herbicidally effective amount of mesotrione to control weeds in such crop. It appears that the Examiner has failed to appreciate an important aspect of the present invention – and that is that the second herbicide recited in the claims has been shown to act as a "safener" for mesotrione use in sorghum (as discussed on pages 1 and 2 of the specification).

The teaching of Cornes is limited to a herbicidal composition comprising mesotrione and a second herbicide for controlling weeds in crops such as corn (maize), wheat, rice, potato or sugarbeet. Cornes contains no specific and unambiguous teaching regarding the control of weeds in sorghum crops. Nor does Cornes suggest that injury to sorghum occasioned by use of mesotrione to control weeds can be reduced by use of a second herbicide selected from one or more of prosulfuron, dicamba, 2,4-D, halosulfuron-methyl and quinclorac.

Likewise, the teaching of Hacker et al. is limited to herbicidal combinations (A)+(B) useful for controlling weeds in cereal crops that are tolerant to the herbicides (A) and (B), wherein (A) is a broad spectrum herbicide such as glyphosate and (B) is a selective herbicide,. The reference provides a long list of selective herbicides (B) that incidentally includes mesotrione. However, Hacker et al. does not teach or suggest the presently claimed invention.

To the contrary, Hacker et al. teaches away from the presently claimed process as the reference exemplifies wild cereal forms of Sorghum spp. as weed species to be controlled by the herbicide compositions therein:

Examples of weed species on which the herbicidal compositions act efficiently are, from amongst the monocots, Alopecurus spp., Avena spp., Setaria spp., Apera spica venti, Digitaria spp., Lolium spp. and Phalaris spp., but also Brachiaria spp., Panicum spp., Agropyron spp., wild cereal forms, Sorghum spp., Echinochloa spp., Cynodon spp., Poa spp., and Cyperus species and Imperata. (Col. 13, lines 17 – 23). Emphasis added.

Accordingly, Applicants respectfully submit that one of ordinary skill in the art would not look to the disclosure of Hacker et al. for a process for reducing injury in a crop comprising sorghum.

The deficiencies of the primary references are not remedied by the secondary reference. Kent et al. is merely cited for the proposition that sorghum is a cereal crop. The secondary reference provides no teaching or suggestion which would lead one of ordinary skill to modify either of Cornes or Hacker et al. in order to arrive at the presently claimed invention (a process for reducing injury in a crop comprising sorghum from application of a herbicidally effective amount of mesotrione to control weeds in such crop).

The Examiner has not provided the requisite motivation and suggestion in the prior art to combine the references. The Examiner has essentially collected references that teach various elements of the claimed invention, but has failed to properly combine the references so as to make out a *prima facie* case of obviousness. One of ordinary skill in the art would not be motivated to modify any of the applied references so as to obtain the claimed invention. The claims are unobvious because there is no suggestion to combine all of the particular teachings in the prior art so as to obtain the invention claimed as a whole. The only suggestion to combine the individual elements alleged to be taught in the prior art comes from teachings contained in Applicants' own disclosure of the invention which is improper hindsight. A collection of teachings from various references of individual claim elements without more does not establish *prima facie* case of obviousness.

Moreover, Applicants respectfully submit that in reaching a conclusion of obviousness, the Patent and Trademark Office must consider the "invention as a whole," which includes evidence of the invention's unexpected results. See *In re Margolis*, 228 USPQ 940 (Fed. Cir. 1986). Specifically, as is indicated in tables 1 and 2 of the present application, the use of mesotrione along with one or more specific second herbicides provides reduced damage to sorghum as compared with the use of a composition comprising mesotrione alone. This finding, to which the present invention relates, is completely unexpected and could not be predicted on the basis of the prior art documents cited by the Examiner -- since they are all silent in this regard.

In view of the foregoing, Applicants contend that the disclosures in Cornes and Hacker et al., either taken alone or in combination with Kent et al., are inadequate to support a rejection of claims 1 -- 3 or new claims 5 -- 8 grounded upon 35 USC § 103. Reconsideration and withdrawal thereof are earnestly requested.

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With the amendments and explanations presented herein, the Examiner is respectfully requested to reconsider the rejections. Applicants respectfully submit that the present application is now in condition for allowance. A Notice of Allowance is respectfully solicited.

Respectfully submitted,

USPTO Customer No. 26748
Syngenta Crop Protection, Inc.
Patent and Trademark Dept.
410 Swing Road
Greensboro, NC 27409
(336) 632-7895

/William A. Teoli, Jr./
William A. Teoli, Jr.
Attorney for Applicants
Reg. No. 33,104

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